

REMARKS

Election/Restriction Requirement

Paragraphs 1, 2, and 3 of the Official Action relate to a restriction requirement applied to the claims originally filed in this application. In response, the applicants provide the following
 5 comments.

The applicants have invented, disclosed and claimed a broad and basic invention. The invention is directed to the use of information relating to the geographic position of a user, variously in combination with other information, to effect the intelligent selection of good and services (including information) in telephony and electronic commerce.

10 Two distinct issues are raised by the “Election/Restriction” requirement.

First, the ***election requirement*** derives from the rule prohibiting “two or more independent and distinct inventions (from being) claimed in one national application.” 37 C.F.R. §1.141. The Examiner is correct in noting at page 2 of the Office Action that no claim in this case was generic as to the combination of on-screen programming guides (Species A-1) and
 15 Geographical Position (Species A-2). The applicants confirm the provisional election made on January 9, 2003 to elect A-2, and therefore have cancelled claims 1-20 in this amendment as being drawn to non-elected subject matter, without any waiver, prejudice, or disclaimer of the applicants’ rights to prosecute the subject matter recited in such claims in future divisionals or continuations of the instant application.

20 Second, the ***restriction requirement*** derives from the rule permitting the presentation of a generic claim, but allowing the examiner to require the applicant to identify “a species to which the claim will be restricted if no claim to the genus is found to be allowable.” 37 C.F.R. §1.146. This rule acknowledges and embraces the concept that the applicants are fully entitled to claim their invention as generically as supported by the application, and as the prior art permits. The
 25 applicants originally presented independent claim 21 as a genus claim to the “Geographic Position” species. By this amendment, additional independent claims 24, 68, 72, 76, 194, 195, 196, and 197 are presented which address the concept in various ways. So long as the claims are supported, a patent applicant is entitled to present various independent claims. *See e.g., Tandon v. United States International Trade Commission*, 831 F.2d 1017, 4 USPQ 2d 1283 (Fed. Cir.

1987). Accordingly, the applicants reconfirm the provisional election of ‘Wireless Electronic Communication’ (Species D-1) and ‘Geographic Position Is Determined By A GPS’ (Species E-1), but respectfully urge that the genus claims are fully allowable for the reasons set forth below.

Non-Art Objections and Rejections

5 Paragraphs 4, 5, and 6 of the Official Action dealt with various objections lodged against the drawings. The applicants respond to the objections set forth in each of these paragraphs by submitting copies of the drawings as originally filed, with proposed revisions shown in red ink. The applicants request consideration of the redlined drawings, and reconsideration and withdrawal of the objections to the drawings set forth in paragraphs 4, 5, and 6. The applicants
10 propose submitting new formal drawings after the examiner approves the redlined changes.

Regarding the objections set forth in paragraph 4, the applicants have replaced the reference numeral 84 associated with the “imaging system” shown in Figure 3 with the reference numeral 82. Regarding the drawing objection stated in paragraph 5, the applicant has redlined Figure 3 to replace the reference numeral 150 associated with the box labeled “Web Access”
15 with the reference numeral 130. Regarding the drawing objection stated in paragraph 6, the applicant has redlined Figure 3 to remove the reference numeral and associated text “134 Web Access” appearing at the upper right hand corner of Figure 3, and has added an arrow running from the reference sign “134 Web Access Connection” appearing in the lower center of Figure 3, to represent the processing described on page 28, lines 20-27 of the specification.

20 Paragraph 7 of the Official Action objected to several informalities appearing throughout the disclosure. The applicant has addressed each of the informalities appearing on page 16, 25, 26, and 30. Regarding the informality appearing on page 30, line 5, the applicant has added the new reference numeral “62A” in red ink to Figure 2 of the drawings, and has changed the reference numeral 70 appearing on page 30, line 5 to the reference number “62A”. Finally,
25 regarding the term “global positioning satellite”, the applicant located two occurrences of that term, and have replaced each of those occurrences as suggested in the Official Action.

Paragraph 8 of the Official Action objected to claim 38 as failing further to limit claim 37. In response, the applicants have amended claims 37 and 38, with claim 37 reciting an offer that expires after a specified interval of time, while claim 38 recites an offer that expires at a

specified certain time. The applicants request reconsideration and withdrawal of the objections stated in paragraph 8.

Paragraphs 9 and 10 of the Official Action rejected claims 21-24, 34-40, 42, and 43 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter that applicant regards as the invention. In response, the applicant has amended claim 21 to provide better antecedent basis for the “the item”. The applicant has amended claim 39 as indicated to address the antecedent basis issue raised in paragraph 10 of the Official Action. The applicant has also amended claim 40 as indicated to clarify that the offer referred to in claim 40 is the same offer referred to in claim 21. Finally, as discussed in further detail below, the applicant has amended claim 24 to replace the reference to a “global positioning satellite” with the term “global positioning system”.

Art-based rejections (Fano and Kolls)

Turning to the art-based rejections, Paragraphs 11 and 12 rejected claims 21, 22, 24, 34, 35, 37-40, and 43 under 35 U.S.C. § 102(e) as being anticipated by Fano, while Paragraphs 13 and 14 reject claims 23, 36, and 42 as being unpatentable over Fano in view of Kolls.

As discussed during the interview referenced above, rejected claims 21, 22, 23, 36, 39, 40, 42, and 43 were found to be supported under § 112, first paragraph, by US patent 6,055,513 (hereafter the “ ’513 patent”), which is a parent case of the present application. Accordingly, these claims have an effective filing date that precedes the effective date of Fano as a reference. Thus, the applicants request withdrawal of Fano as a reference citable against these claims. Exhibit A included herewith is a claim chart detailing support for these claims in the ‘513 patent.

To clarify that the instant application is a continuation-in-part of the subject matter disclosed in the ‘513 patent, the applicants have amended the specification under the heading “Related Application Information” as indicated above. The applicants submit that MPEP § 201.11 requires no fee or petition to make this revision, since the application was filed before 29 November 2000.

In the course of preparing this response, the applicants have recently discovered, and enclose for the Examiner’s consideration, a paper authored by Andrew E. Fano and apparently

presented at a conference in 1998. This item is cited as item # A11 on the Supplemental IDS mailed on 29 May 2003.

Regarding independent claim 21 in particular, the applicants have amended it further to clarify the invention as recited therein. The applicants request reconsideration of claim 21 and all claims depending therefrom.

Regarding formerly dependent claim 24, the applicants have rewritten it in independent form modeled generally on revised claim 21, but further reciting input from a global positioning system. The applicants submit that this feature is fully supported at least by the subject matter added to the specification as filed on 17 October 2000. The applicants have also amended claims 34, 37, and 38 to depend from claim 24. Regarding claims 24, the applicants submit that Fano fails to meet all of the features recited therein, including but not limited to providing a follow-on offer to the user in real-time with a primary transaction based upon geographic position of the user, the identity of the user, and a further data element related to the user. The applicants further submit that Kolls fails to provide any teaching missing from Fano. The applicants request reconsideration of claim 24 and all claims depending therefrom.

New Claims 44-197

The applicants submit for consideration new claims 44-197, which recite various aspects of the invention as disclosed herein. Within this new set of claims, the following claims are believed fully supported by the '513 patent and entitled to the filing date thereof: dependent claims 44-50 depending from claim 21, independent claim 68 and claims 69-71 depending therefrom, and all of independent and dependent claims 76-197. In the interest of conciseness, the applicants have not provided page and line citations of support for these new claims, but will gladly do so if requested.

The following claims are believed fully supported at least by the subject matter added in the 17 October 2000 filing of the instant application: dependent claims 51-67 depending from claim 24, and independent claim 72 and claims 73-75 depending therefrom. The additional fees for these claims are submitted herewith.

Conclusion

In conclusion, the applicants submit that, after entry of the above amendments and new claims, the pending claims will be supported as follows:

by parent '513 patent: claims 21-23, 36, 39, 40, 42-50, 68-71, and 76-197; and

at least by subject matter filed on 17 October 2000: claims 24, 34, 35, 37, 38, 51-67, and
5 72-75.


The applicants request entry and consideration of this response, and request favorable action at the earliest convenience of the Office.

Respectfully submitted,

WEST CORPORATION

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By:



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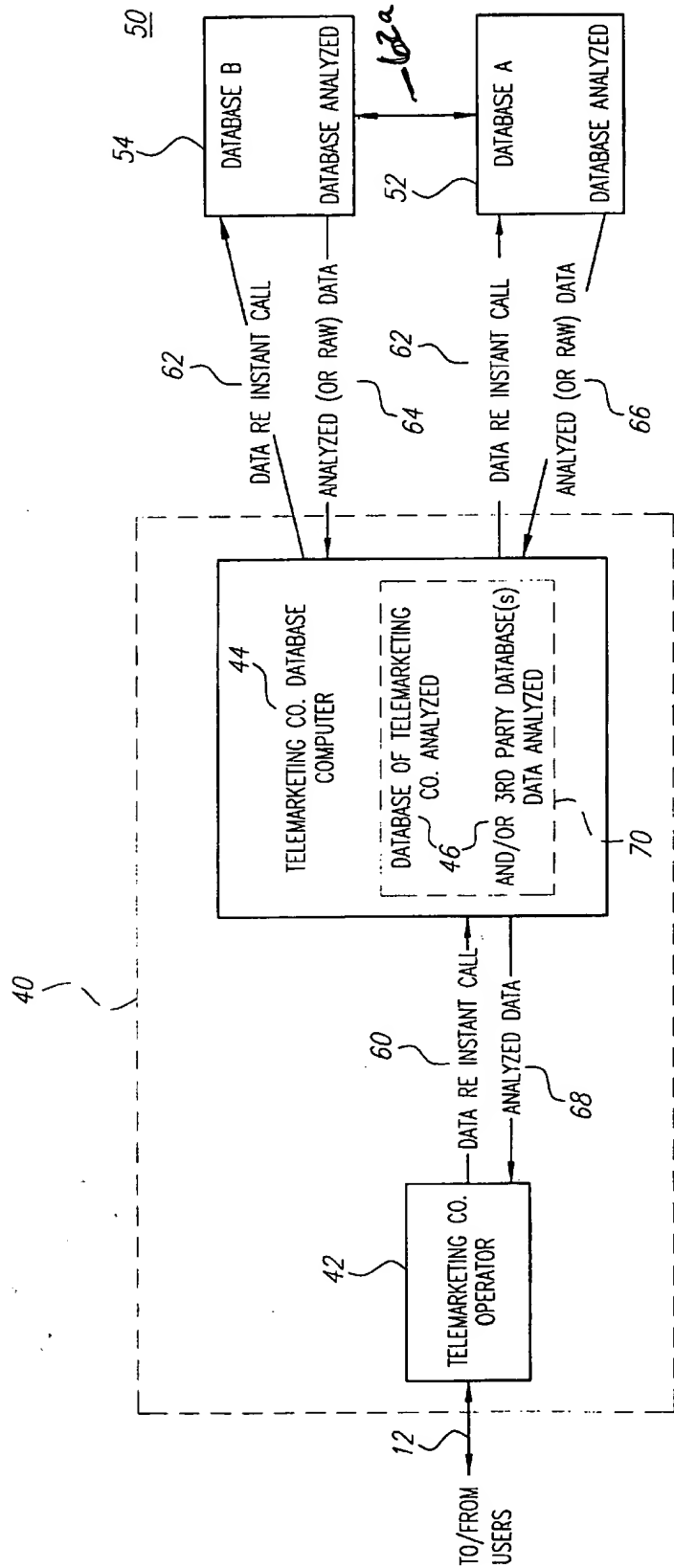


FIG. 2

approved for entry for 10/1/03



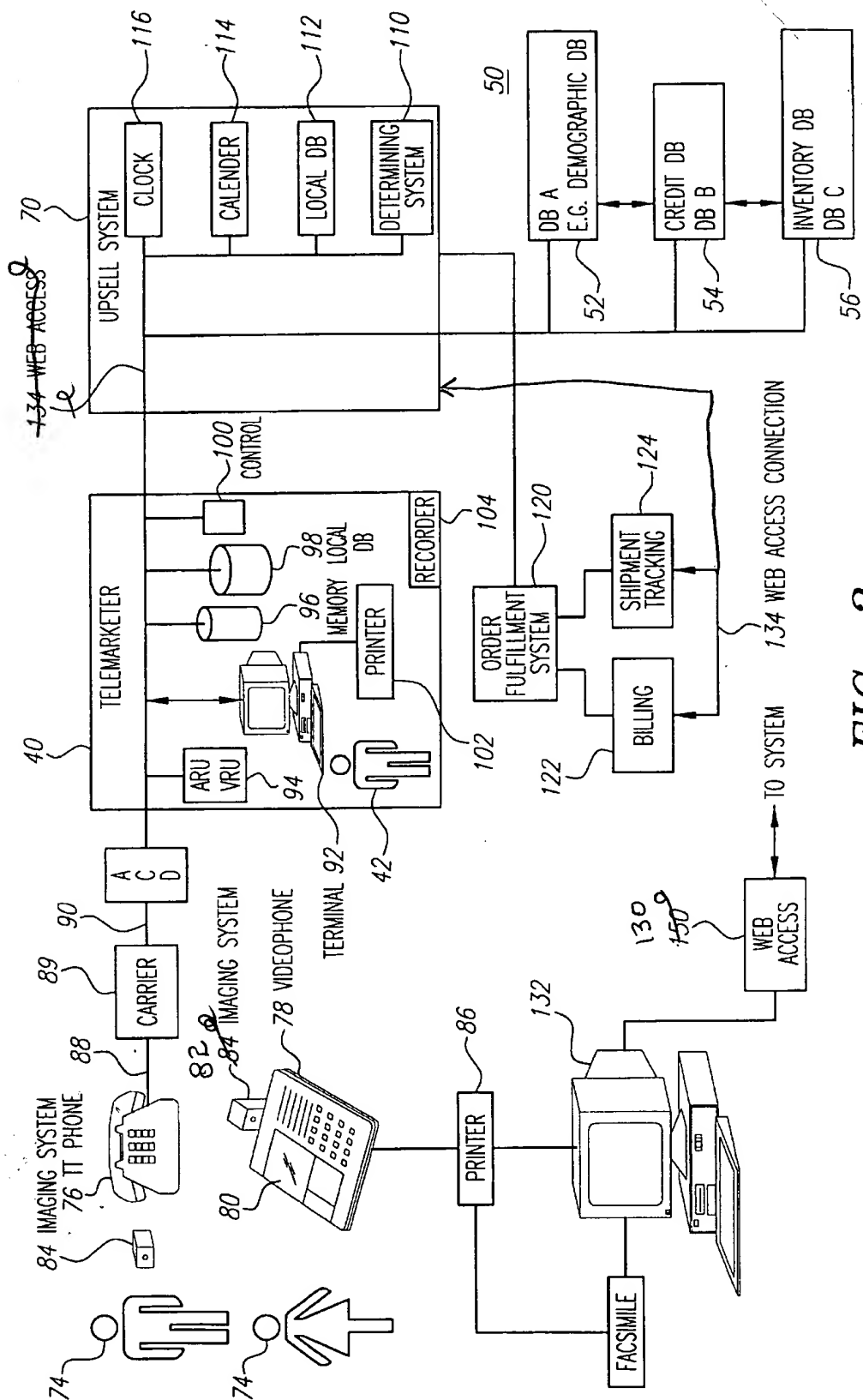


FIG. 3

